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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,713	10/10/2001	Benoit Patrick Bertrand	05222.00175	3443

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BANNER & WITCOFF AND ATTORNEYS FOR ACCENTURE  
10 S. WACKER DRIVE, 30TH FLOOR  
CHICAGO, IL 60606

EXAMINER

HOLMES, MICHAEL B

ART UNIT	PAPER NUMBER
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2121

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/868,713

Applicant(s)

BERTRAND ET AL

Examiner

Michael B. Holmes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2-1-02
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed Office Action.



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**Examiner's Detailed Office Action**

1. This Office Action is responsive to application 09/868,713, filed October 10, 2001.
2. Claims 1-18 have been examined.

**Claim Rejections - 35 USC § 101**

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. The invention as disclosed in claims 1-9 are rejected under 35 U.S.C. 101 as being non-statutory subject matter. While applicant's invention is directed towards technological arts.

Applicant's claim language is not limited to practical applications. In particular, examiner has found the claimed subject matter, to be one of three exclusions recognized, outside the statutory category of invention, an abstract idea. Examiner contends that applicant's invention as claimed relates a computational model or a mathematical manipulation of a function or equation, as such, a process that merely manipulates an abstract idea or performs a purely mathematical algorithm

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is nonstatutory despite the fact that it might inherently have some usefulness. In *Sarkar*, 588 F.2d at 1335, 200 USPQ at 139, the court explained why this approach must be followed:

No mathematical equation can be used, as a practical matter, without establishing and substituting values for the variables expressed therein. Substitution of values dictated by the formula has thus been viewed as a form of mathematical step. If the steps of gathering and substituting values were alone sufficient, every mathematical equation, formula, or algorithm having any practical use would be per se subject to patenting as a "process" under 101. Consideration of whether the substitution of specific values is enough to convert the disembodied ideas present in the formula into an embodiment of those ideas, or into an application of the formula, is foreclosed by the current state of the law.

Furthermore, for such subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts.

*See Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). *See also Alappat* 33 F.3d at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring) ("unpatentability of the principle does not defeat patentability of its practical applications") (citing *O'Reilly v. Morse*, 56 U.S. (15 How.) at 114-19). A claim is limited to a practical application when the method or system, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. *See AT &T*, 172 F.3d at 1358, 50 USPQ2d at 1452. *See MPEP* § 2106(IV)

Applicant is advised to make the appropriate corrections in an attempt to gain patentability.

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. Remember, the claims define the property rights provided by a patent, and thus require careful scrutiny. Therefore, it is not enough to set forth invention in the specification.

The claims must also reflect the scope and breath of applicant's invention.

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5. Therefore, claims 1-9 are rejected under 35 USC § 101.
6. It should be noted that if the claimed subject matter were amended to recite the invention of which, being implemented on a computer or processor or computer-implemented method or process or whatever word(s) or phrase(s) the written description of the specification recites for that feature(s) of the computer. The rejection under 35 USC § 101 would be withdrawn.

### Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-6 & 10-15 are rejected under 35 U.S.C. 102(b) as being anticipated by *Cook et al.* (USPN 5,727,950).

Regarding claim 1. *Cook et al.* teaches a method for creating a presentation, comprising the steps of: (a) presenting information indicative of a goal [see C 5, L 20-31 & C6, L 57-65

*Examiner interprets a goal to be: to direct to or the end toward which a specified effort or object is direct, in this case the computer-assisted learning provide by the virtual tutor and improved learning skills of the student* ]; (b) integrating information that motivates accomplishment of the goal [see C 5, L 32-63]; (c) receiving input from a student [see C6, L 57-65; (d) analyzing system tools that process the input from the student; [see Abstract] and (e) providing feedback to assist the student in utilizing the presentation to accomplish the goal [see C 5, L 46-55].

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Regarding claim 10. *Cook et al.* teaches an apparatus that creates a presentation, comprising; (a) a processor [see C 16, 4-30]; (b) a memory that stores information under the control of the processor [see C 16, 4-30]; (c) logic that presents information indicative of a goal [see C 31, L 24-34]; (d) logic that integrates information that motivates accomplishment of the goal [see C 31, L 36-58]; and (e) logic that receives input from a student [see C 31, L 24-34]; (f) logic that analyzes system tools that process the input from the student [see C 31, L 59 to C 32, L 2]; and (g) logic that provides feedback to assist the student in utilizing the presentation to accomplish the goal [see C 32, L 15-27].

Regarding claims 2, 3, 5, 11, 12, 14. *Cook et al.* teaches feedback includes video information, audio and simulated information [see C 3, L 40-52 & C 36, L 54 to C 37, L 4]

Regarding claims 4, 6, 13 & 15. *Cook et al.* teaches feedback includes electronic mail information [see C 6, L 50-56 & C 25, L 19-34].

### Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7-9 & 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Cook et al.* (USPN 5,727,950) in view of *Walker et al.* (USPN 5,862,223).

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*Cook et al.* has been discussed above and does not teach the limitations of claims 7-9 & 16-18.

However, *Walker et al.* teaches the limitations of claims 7-9 & 16-18.

Regarding claims 7-9 & 16-18. *Walker et al.* describes feedback includes telephony, video conferencing and chat room information [see Abstract, C 9, L 1-18; C 26, L 22-44 & C 15, L 10-20].

It would have been obvious at the time the invention was made to a persons having ordinary skill in the art to combine *Cook et al.* with *Walker et al.* because computerized marketplaces of all kinds are well known in the art. They range from simple classified ad bulletin boards to complex mainframe-based market systems such as NASDAQ which offers a real-time market-making system for tens of thousands of securities brokers. All modern stock, bond and commodity exchanges are supported by underlying computerized databases and related systems which enable them to function [see C 1, L 14-21].

### Correspondence Information

11. Any inquires concerning this communication or earlier communications from the examiner should be directed to Michael B. Holmes, who may be reached Monday through Friday, between 8:00 a.m. and 5:00 p.m. EST. or via telephone at (571) 272-3686 or facsimile transmission (571) 273-3686 or email [Michael.holmesb@uspto.gov](mailto:Michael.holmesb@uspto.gov).

If you need to send an Official facsimile transmission, please send it to (571) 273-8300.

If attempts to reach the examiner are unsuccessful the Examiner's Supervisor, Anthony Knight, may be reached at (571) 272-3687.

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Hand-delivered responses should be delivered to the Receptionist @ (Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22313), located on the first floor of the south side of the Randolph Building.

***Michael B. Holmes***

Patent Examiner

Artificial Intelligence

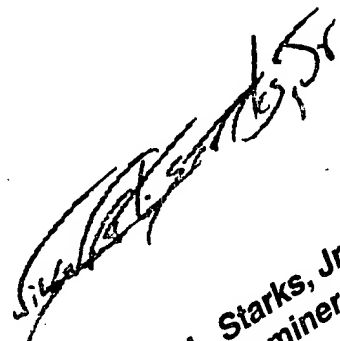
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United States Department of Commerce

Patent & Trademark Office

*Tuesday, August 02, 2005*

*MBH*

A handwritten signature in black ink, slanted upwards from left to right. The signature appears to read "Wilbert L. Starks, Jr." and is written in a cursive, stylized font.

**Wilbert L. Starks, Jr.  
Primary Examiner  
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